



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,741	03/22/2001	Bruno Messmer	1141188-3/DU	6555

22850 7590 03/26/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

PHAN, JOSEPH T

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,741

Applicant(s)

MESSMER, BRUNO

Examiner

Joseph T Phan

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 28 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 lines 9-12 recite "...together with an identification of the subscriber ,who has given the message, subscriber's address messages to subscribers..." it is unclear and confusing if "...the subscriber..." is relating to the transmitting subscriber or the receiving subscriber, or if the subscriber is the same subscriber that gives the message. Furthermore, it is unclear what "...subscriber's address messages" refers to, the subscriber's message being given or a subscriber's address being sent as a message.

Claim 28, lines 13-14, recite "...the list of the respective subscriber, the said subscriber..." lacks antecedent basis. It is unclear which subscriber it is referring to. Appropriate clarification or correction is required(i.e. distinguishing subscribers as a transmitting, receiving, identified, single, or grouped subscriber).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 2645

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**3. Claims 19-36 rejected under 35 U.S.C. 102(e) as being anticipated by
Carleton et al., Patent #6,069,940.**

Regarding claim 19, Carleton teaches a message exchange for receiving and storing spoken messages and transmitting these messages to one or more subscribers, to whom the messages are addressed, in a public switched telephone network, to which the message exchange is connected, wherein the message exchange(Fig.1) comprises: an address module in order to store a plurality of lists with subscriber identifications, the lists being assigned, in each case, to at least one subscriber in the telephone network (col.10 lines 29-47), and, in the address module, certain subscriber identifications in a list of a subscriber being combined into a group(col.10 lines 48-61); a receiving module in order to receive the messages from subscribers in the telephone network via the telephone network and store them, in each case, together with an identification of the subscriber who has placed the message (col.10 lines 29-61); a speech recognition module, which makes it possible for a subscriber to determine, by means of spoken language, subscribers and/or groups of subscribers to whom a message is supposed to be addressed (col.9 lines 46-58 and col.10 lines 29-61) a transmission module in order to transmit stored messages, by means of an automatic call, to the determined subscribers and/or groups of subscribers and a reply module for receiving and storing replies of a subscriber to whom messages are transmitted (Fig.1 and col. 10 lines 29-61).

Regarding claim 20, Carleton teaches the message exchange according to claim 19, wherein the speech recognition module makes it possible for a subscriber to create administer the lists by means of spoken language (col.10 lines 29-61).

Regarding claim 21, Carleton teaches the message exchange according to claim 19, wherein a subscriber identification comprises the name of the respective subscriber (col.10 lines 29-61).

Regarding claim 22, Carleton teaches the message exchange according to claim 19, wherein a subscriber identification comprises the call number of the respective subscriber(col.10 lines 29-61).

Regarding claim 23, Carleton teaches the message exchange according to claim 19, wherein certain subscriber identifications are stored as voice signals(col.10 lines 29-61; spoken header).

Regarding claim 24, Carleton teaches the message exchange according to claim 19, wherein the message exchange comprises at least one tariff table, which makes it possible for the transmission module to transmit certain messages at times having economical tariffs(Fig.1, col.6 lines 33-67, and col.10 lines 48-61).

Regarding claim 25, Carleton teaches the message exchange according to claim 19 wherein the message exchange comprises a table with statistical information on the traffic load in the telephone network, which makes it possible for the transmission module to transmit certain messages at times of low traffic load (Fig.1, col.6 lines 33-41, 61-67, and col.10 lines 48-61).

Regarding claim 26, Carleton teaches the message exchange according to claim 19, wherein the reply module can receive a reply, store and transmit, to the addressed subscribers, messages from a subscriber to whom messages were sent, which messages can be addressed to a group of subscribers (col.10 lines 29-61).

Regarding claim 27, Carleton teaches the message exchange according claim 19, wherein a list also contains access rights (col.6 lines 61-67).

Regarding claim 28, Carleton teaches a method of receiving and storing spoken messages, and transmitting these messages to one or more subscribers in a public switched telephone network comprising;

storing a plurality of lists, with subscriber identifications, in a message exchange connected to the telephone network, the lists being assigned, in each case, to at least one subscriber in the telephone network, and certain subscriber identifications in a list of a subscriber being combined in a group (col.10 lines 29-61);

receiving, in the message exchange, messages of subscribers in the public switched telephone network via the said telephone network and storing, in each case, together with an identification of the subscriber, who has given the message, subscriber's address messages to subscribers and/or groups of subscribers by designating to the message exchange the respective subscribers or groups of subscribers by means of spoken language (col.10 lines 29-61);

identifying, by use of a speech recognition module, the list of the respective subscriber, the said subscribers and/or groups of subscribers designated by the subscriber (col.10 lines 29-61);

transmitting, by means of an automatic call with the message exchange, stored messages to the identified subscribers and/or groups of subscribers; and receiving and storing, by means of the message exchange, replies of a subscriber, to whom messages were transmitted (col.10 lines 29-61)

Regarding claim 29, Carleton teaches the method according to claim 28, wherein certain subscriber identifications are stored as voice signals (col.10 lines 29-61).

Regarding claim 30, Carleton teaches the method according to claim 28, wherein status information is stored concerning the transmission of messages to subscribers, and messages not successfully transmitted can be repeatedly transmitted (col.10 lines 48-61).

Regarding claim 31, Carleton teaches the method according to claim 28, wherein at least one tariff table is monitored, and certain messages are transmitted to addressed subscribers at economical tariff times(Fig.1, col.6 lines 33-67, and col.10 lines 48-61).

Regarding claim 32, Carleton teaches the method according to claim 28, wherein statistical information on the traffic load in the telephone network is stored in a table, and certain messages are transmitted to the addressed subscribers at times of low traffic load(Fig.1, col.6 lines 33-67, and col.10 lines 48-61).

Regarding claim 33, Carleton teaches the method according to claim 28, wherein certain messages are transmitted via the Internet(Fig.1,col.1 lines 21-51, and col.10 lines 48-67).

Regarding claim 34, Carleton teaches the method according to claim 28, wherein messages, from a subscriber to whom messages were sent, are received as reply,

Art Unit: 2645

stored and transmitted to the addressed subscribers, which messages can be addressed to a group of subscribers (Fig.1, col.6 lines 33-67, and col.10 lines 48-61).

Regarding claim 35, Carleton teaches the method according claims 28, wherein certain subscribers administer the lists by means of spoken language(Fig.1, col.6 lines 33-67, and col.10 lines 48-61).

Regarding claim 36, Carleton teaches a computer-readable data carrier, which contains coded data representing a computer program, which makes it possible to control a message exchange according to claim 29 in such a way that it carries out a method according to claim 28(Fig.1, col.6 lines 33-67, and col.10 lines 48-61).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T Phan whose telephone number is 703-305-3206. The examiner can normally be reached on M-TH 9:00-6:30, in every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2645

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTP
March 17, 2004



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

